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09/112,131 07/08/98 WALKER

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TM02/0619

EXAMINER

NGUYEN, G  
ART UNIT PAPER NUMBER

2165  
DATE MAILED:

06/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

SM

# Office Action Summary

Application No.  
09/112,131

Applicant(s)

Walker et al.

Examiner  
Cuong H. Nguyen

Art Unit  
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 177-189 and 192-195 is/are pending in the application.
- 4a) Of the above, claim(s) 192 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 177-189 and 193-195 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. This Office Action is the answer to the communications received on 9/05/2000 (the amendment, and the remarks); which paper has been placed of record in the file.
2. Claims 177-189, 193-195 are pending in this application.

***Priority***

3. Acknowledgment is made of applicants' claim for foreign priority under 35 U.S.C. § 119(a)-(d). The certified copy has been filed in parent Application No. 08/916,154, filed on 9/02/1997.

***Response to Amendment***

4. Applicants' arguments received on 2/28/2001 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. § 103(a) rejections.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire

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on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The following are US Patent case rulings applying in this examination.

A. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim". Therefore, claim's languages are very important, accordingly they are reasonably interpreted in examination process.

B. Referring to the argument on the paper received on 4/09/2001 (page 3, 2nd paragraph), that "...nothing in USPTO procedure entails the claimed steps of "receiving a first expert qualification corresponding to the first expert", nor "transmitting the first expert qualification to a second expert", nor "receiving a signal from a second expert that indicates approval of the first expert qualification"", the examiner submits that this has been widely used in many areas (USPTO might not expressly say exactly as claimed languages, but its telephone directory, as an example, clearly showing the hierarchical order that reflecting above limitations, art unit 705, sub-class 26 defined which examiner having "e-shopping" skills to examining

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this kind of specific cases, the supervisor of this art unit (A.U. 2165) has a senior level of patent examining functions and familiarity with this skill levels; accordingly, he is the one to give a second/first opinion about a limitation, furthermore, a director as (his boss) has had more of this particular skills comparing to an ordinary examiner or a supervisor at USPTO. Upon making decision about a consulted matter, a "YES" or "NO" answer has been given (this may be in oral, or in writing, or using an e-mail) ). USPTO 's method of doing business is related to "expert qualification" comprising a first expert (examiner) and a second expert having authority to approve the first expert qualification. This has been available public knowledge; such as this idea of doing business from USPTO would be implemented in Nielsen's invention by one of ordinary skills in the art (the art here is business method art, it comprises hierarchical authorities: a type of business method). Moreover, in re *Susi*, 169 USPQ 423 (CCPA 1971), the court ruled: Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments; and in *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987), the court ruled: Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

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C. Referring to the argument on the same paper (page 3, 3rd paragraph), that "Nielsen contains no teaching of having a second expert approve a first expert's qualification" (this is not an inventive step, see the response above), "Furthermore, the Harte reference, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method. In any case, Harte certainly does not supply the element, lacking in the other art cited by the Examiner, of receiving a signal from a second expert that indicates approval of a first expert qualification". We are talking about the concept here, the way of automation (computer-implemented) a manual process, is not inventive (see In re Venner).

- Furthermore, see a well-known computer site of eBay.com for actions of: "...concerning steps of receiving a bid on an end user-request ..., ... transmitting such a bid ...". Accordingly, an ordinary skills in the art would be able to implement these ideas in various subject matters using at least eBay's reference.

D. Although operational characteristics of a system may be apparent from the specification, the examiner will not read such characteristics into the claims when they cannot be clearly connected to the structure recited in the claims. See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given

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their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. Cited prior art disclosed structures that meet the claimed limitations although the matter is expressed in different language, the examiner submits that it is analogous with many examples in real-life. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990); ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

E. Claims's language could be read-on by cited references and no reasonable distinguishing limitation has been made in claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

F. The examiner submits that all the limitations are not patentable since **they lack of inventive steps**, i.e. "Receiving a signal from a 2nd expert that indicates approval of a first expert qualification" (in this case, just a "Y" or "N" signal); "allowing the end user to select an expert from the list" (4th

para. Of page 4). The applicants argue "claim 193 is submitted as being patentable since its feature of allowing the end user to select an expert from a list is not taught or suggested by prior art"; actually, this type of action is notoriously well-known in e-commerce or from an end user select a specific expert from a telephone book such as a Yellow Page).

G. On page 5, para. 2, the applicants argue that "the Nielsen reference contains not teaching concerning the steps of receiving a bid on an end user request from an expert, nor transmitting such a bid to the end user. Neither are these steps present elsewhere in the prior art. Accordingly, claim 195 is submitted as being patentable over the prior art by virtue of its recitation of "receiving at least one bid on the end user request from the at least one expert", and "transmitting the at least one bid to the end user". As above, this limitations simply are not patentable since **they lack of inventive steps**; actually, this type of action is notoriously well-known in e-commerce or from an end user select a specific expert from a telephone book such as a Yellow Page).

H. It is reasonable that various modifications of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in

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connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be unduly limited to such specific embodiments. Furthermore, in response to the amendment, the examiner submits court cases which are relevant to applicant's arguments.

6. In re **Sheckler**, 168 USPO 716 (CCPA 1971), the court ruled:

It is not necessary that a reference actually suggest changes or possible improvements which applicant made. The PTO can show that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

7. In re **Bozek**, 163 USPO 545 (CCPA 1969), the court ruled:

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred."

8. In re **Jacoby**, 135 USPO 317 (CCPA 1962), the court ruled:

"Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose", "it is immaterial that reference does not disclose specific function set forth in applicants' specification, since this is merely an additional attribute possessed by reference structure which would be obvious

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to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it".

9. *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPO2d 1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

10. *In re Heck*, 216 USPO 1038 (Fed. Cir. 1983), the court ruled:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

11. *In re Keller, Terry, and Davies*, 208 USPO 871 (CCPA 1981), the court ruled:

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."; and "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

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12. Ex parte Rubin, 5 USPO2d 1461 (BdPatApp&Int 1987), the court ruled: Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

13. In re Conrad, 169 USPO 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

14. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.***

15. Claims 177-189, 193-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Pat. 5,948,054), in view of Harte (US Pat. 4,576,579).

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A. Claims 177-178 are rejected because they "read-on" the steps of "expert matching" e.g. the USPTO Commissioner/the representative's attorney (the end user of a patent application), the examiner (an expert/master in his field by art unit/(classification subject), the Supervisory Patent Examiner (second expert who has a higher experience/authority compared to the first expert (his examiner). A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices from his SPE (second expert); this 2nd expert approves who is right in his art unit for the job of examining this particular case (e.g. depending on a specific subject matter such as insurance, e-shopping, e-coupons, banking, .etc., he appoints one of his examiner who is expert in this specific field; the SPE is always a senior, experience examiner who can guarantee his examiner 's level of expertise to the Commissioner/the representative's attorney (the end user). Therefore, this rationale/reference would read-on the claim's language.

B. Referring to claims 193-195: The field of application is "expert matching" with assistance of a computer system.

Nielsen obviously suggests an expert matching computer for managing communications between an expert and an end user (see **Nielsen**, the abstract; Figs.6, 7), comprising:

- inherent features of a controller unit for receiving an end user request (see **Nielsen** Fig.1 refs.139, 143; Fig.4), the controller unit having a database for storing therein a plurality of expert qualifications (see **Nielsen** Fig.1 refs.139, 143), each expert qualification associated with an expert address stored in the database and corresponding to a particular expert (see **Nielsen** Fig.1, refs. 139, 143, Figs.2, 5);

- inherent features of a means for classifying request (see **Nielsen** the abstract, Figs.2, 3, 5, 7 refs.213, 305);

- inherent features of a means for providing an expert address which corresponds to a request's classification (see **Nielsen** Figs.1, 2, 3, 5 refs. 213, 305);

- inherent features of a means to identify:
  - an expert corresponding to a request's field/classification; an identified expert address corresponding to the identified expert (these features of the claim are notoriously well-known in the art (e.g. a Patent & Trademark Office's examiner who examines applications of a particular US Classification (for example class 705 subclass 28); his art unit, Technology Center, his phone number, his Office location .etc.; see also Hart for implicit suggestions);

Nielsen does not disclose exactly a claim's language in using his concept as claimed by the applicants.

However, all the claimed limitations are analogously well-known in the above field. For example, a controller unit for receiving a request to grade a multiple choice test, it would define a testing level and selecting an appropriate test level questions (a requested expert qualification), this controller unit (computer using for testing) having a database for storing a plurality of test levels/(expert qualifications), each stored level/(different expert qualification) corresponding to an appropriate test/(expert of a plurality of sub-level experts), each stored test answer template/(expert qualification) being associated with an address stored in the database and corresponding to a test/an expert .etc. (see Hart for these implicit suggestions). Then, these means are notoriously involved in this test:

- means for selecting/searching the database to identify a test/expert corresponding to the requested test/qualification and an address corresponding to the identified test (see Hart for these implicit suggestions);

- means for requesting management 's approval of a specific test (a standard of qualification) to a corresponding level of grade; and means to receive a response on that matter (this is analogous to "receiving a signal from the second expert (e.g. from manager) that indicates approval of the first expert

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qualification (a specific test)", and similar as above to "receiving a signal from the set of experts (e.g. many supervisors) that indicates approval of the first expert qualification") (see Hart for these implicit suggestions) (this response also answers arguments on para.2,4-5 of page 4 in the amendment received on 9/05/2000; see also *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958)).

- means for authenticating data (e.g. checking tester's I.D., and picture I.D., checking authorized personnel in a test room .etc.);

- means for guaranteeing payment to the selected test (a test fee is administered in order to take the test or in order to have test results);

- means for initiating remittance of payment to a test (application accompanying a testing fee as initiation);

- means for selecting the end user requests for test evaluation (e.g. a teacher, a student, an employer);

- means for transmitting a portion of test result to the address corresponding to an identified result template (e.g. for adjusting the result in a test template);

- means for receiving a test answer/result in response to the end user request (this means is notoriously well-known in the

art for receiving a test result (i.e. a student would receive a test result from a teacher);

- means for transmitting test answers to the end user (this means is notoriously well-known in the art for transmitting test answers e.g. to an employer, or "to whom it may concern");

In other words, these limitations can be done exactly by a computer system from a testing lab (see Hart for these implicit suggestions). One of ordinary skills in the art at the time of the invention would have found these claim's limitations would be very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because all cited references would suggest using a similar means and applying a similar concept as a expert matching computer to select an appropriate source for a specific solution.

C. Referring to claims 177-189: The limitations of these claims recite the same claim limitations as claims 193-195 discussed above. The same analysis and reasoning set forth above in the rejection for obviousness of claims 192-195 applied to these claims also because they are just computer and method claims for the above device; moreover these claims may have more broader limitations. The examiner considers specific limitations that the applicants said "significant limitations" are inherent/obvious in the rationale/prior art in claim 177-189 since they are notoriously well-known in the business art.

#### **Conclusion**

16. Claims 177-189, 193-195 are rejected.

17. The following references are considered pertinent to applicants' disclosure.

- Nielsen (US Pat. 5,948,054 filed on 2/27/1996) published on 9/07/1999, about a method and a system for facilitating the

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exchange of information between human users in a networked computer system.

- Esther Dyson, "Information, bid and asked", Forbes, v146, n4, p92(1), 8/20/1990; (from Dialog(R) file 47).

18. Remarks: A. About automating a manual activity:

A. The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. In *re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958) (in response to page 3, 3rd para. about "Nielsen contains no teaching of having a second expert approve a first expert's qualification. Furthermore, the Harte reference, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method...").

B. About applicant's argument of cited reference "Teaching Away"  
*Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987), the court said:  
Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

C. In *re Susi*, 169 USPQ 423 (CCPA 1971), the court said:  
Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

D. About "read-on" with claimed languages



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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

A handwritten signature in cursive script, reading "Cuong H. Nguyen". The signature is written in black ink and is positioned above the printed name and date.

Cuong H. Nguyen  
June 18, 2001